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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,616	04/02/2004	Kia Silverbrook	HYG015US	9410

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EXAMINER

KIM, TAE W

ART UNIT PAPER NUMBER

2876

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,616

Applicant(s)

SILVERBROOK ET AL.

Examiner

Tae W. Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Amendment filed on May 22, 2006. Receipt is also acknowledged of the Amendment dated July 31, 2006 that clarifies the applicant intention with respect to claim 28. This latest amendment was received as an enclosure to an email response to the examiner's inquiry.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim(s) 1, 2, 4-6, 11-13, 14, 15, 17, 18, and 23 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogulski (US 4071740) in view of Axelrod (US 5337358).

Re claim 1: Gogulski discloses a shopping system comprising: a shopping receptacle (fig 1 part 22) having a shopping receptacle identity (col 7 lines 56-58), the shopping receptacle comprising a sensing device adopted to transfer shopping receptacle identity data (col 7 lines 52-58 discloses transmission and/or broadcasting by carts; therefore the existence of a device for transmitting and/or broadcasting is inherent. The entire control panel (fig 1 part 12) is considered to be a sensing device.).

However, Gogulski does not disclose or fairly suggest a card for identifying a user to a computer system using a sensing device, the card having an interface surface having disposed thereon or therein coded data, the coded data including a plurality of coded data portions, each coded data portion being indicative of an identity of the user.

Axelrod however discloses a card for identifying a user to a computer system using a sensing device (fig parts C & 24), the card having an interface surface having disposed thereon or therein coded data (fig parts CB & CF), the coded data including a plurality of coded data portions, each coded data portion being indicative of an identity of the user (col 3 lines 15-22).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Axelrod's card for identifying a user to a computer system using a sensing device, the card having an interface surface having disposed thereon or therein coded data, the coded data including a plurality of coded data portions, each coded data portion being indicative of an identity of the user to Gogulski's shopping system for the purpose of authenticating the card and discouraging counterfeits. Authenticating plurality of user identifying data including both the encoded data and the non-encoded data would strengthen the security of the card.

Re claims 2 & 15: Gogulski as modified by Axelrod discloses the shopping system of claim 1 and the method of claim 12, wherein each coded data portion is provided at a respective position on the interface surface (Axelrod: fig parts CB & CF), and wherein the sensing device (Axelrod: fig part 24) generates indicating data indicative of at least one of:

- (a) a position of the sensed coded data (Axelrod: col 5 lines 1-5);
- (b) a position of the sensing device relative to the interface surface;

- (c) an orientation of the sensed coded data; and,
- (d) an orientation of the sensing device relative to the interface surface.

Re claims 4 & 13: Gogulski as modified by Axelrod discloses the shopping system of claim 1 and the method of claim 12, wherein the computer system responsive to and the action is at least one of:

(a) associate the shopping receptacle with the user (Gogulski: col 2 line 52 – col 3 line 19: while the shopper is using the cart, the cart is associated with the shopper; therefore the preceding step of associating the shopping receptacle with the user is inherent.); and, (b) dissociate the shopping receptacle and the user (Gogulski: col 3 lines 20-30: the step of disassociating the shopping receptacle and the user is the step of shopper leaving the store without the cart.).

Re claims 5 & 17: Gogulski as modified by Axelrod discloses the shopping system of claim 1 and the method of claim 12, wherein the coded data distinguishes the identity of the user from the identity of every other user known to the computer system (Axelrod: col 1 lines 60-68, col 2 lines 40-44, col 4 lines 59-63: police officer distinguishes the identity of the driver from the identity of every other driver known to the system.).

Re claims 6 & 18: Gogulski as modified by Axelrod discloses the shopping system of claim 1 and the method of claim 12, wherein the coded data is redundantly encoded (Axelrod: col 3 lines 33-66).

Re claim 11 & 23: Gogulski as modified by Axelrod discloses the shopping system of claim 1, the method of claim 12, wherein the coded data is disposed or the method includes

disposing the coded data portion over a substantial portion of the interface surface (Axelrod: fig part CB).

Re claim 12: Gogulski discloses the method of shopping using a card and a shopping receptacle having a shopping receptacle identity and comprising a sensing device (The entire control panel - fig 1 part 12 - is considered to be a sensing device.) including the method for transferring shopping receptacle identity data (col 7 lines 52-58 discloses transmission and/or broadcasting by carts; therefore the existence of a device for transmitting and/or broadcasting is inherent).

However, Gogulski does not disclose or fairly suggest the card having an interface surface having disposed thereon or therein coded data, the coded data including a plurality of coded data portions, each coded data portion being indicative of an identity of a user, and the method includes in a sensing device:

- (a) sensing at least one coded data portion of the interface surface;
- (b) generating, using the at least one sensed coded data portion, indicating data indicative of the identity of the user; and,
- (c) transferring the indicating data to the computer system, the computer system being responsive to the received data to perform an action.

Axelrod however discloses the card having an interface surface having disposed thereon or therein coded data (fig parts CB & CF), the coded data including a plurality of coded data portions, each coded data portion being indicative of an identity of a user (col 3 lines 15-22), and the method includes in a sensing device:

- (a) sensing at least one coded data portion of the interface surface (fig parts CB & 24);

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(b) generating, using the at least one sensed coded data portion, indicating data indicative of the identity of the user (col 1 lines 45-55, col 3 lines 7-22); and,

(c) transferring the indicating data to the computer system, the computer system being responsive to the received data to perform an action (fig parts 20 & 36, col 2 line 63 - col 3 line 2 ; col 4 lines 1-5, 21-24, and 32-34 discloses actions such as displaying and recording.).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Axelrod's card and method to Gogulski's method for the purpose of authenticating the card and discouraging counterfeits. Authenticating plurality of user identifying data including both the encoded data and the non-encoded data would strengthen the security of the card.

Re claim 14: Gogulski as modified by Axelrod discloses the method of claim 12, wherein the method includes, in the computer system:

(a) receiving the indicating data from the sensing device (Axelrod: fig parts 24); and,

(b) determining, using the received indicating data, user identity data indicative of the identity of the user (Axelrod: col 1 lines 45-55, col 3 lines 7-22); and,

(c) performing the action using the user identity data (Axelrod: col 4 lines 1-5, 21-24, and 32-34 discloses actions such as displaying and recording.).

4. Claim(s) 7 and 19 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogulski (US 4071740) as modified by Axelrod (US 5337358) in view of Tame (US 20040026502).

Re claim 7 & 19: Gogulski as modified by Axelrod discloses the shopping system of claim 1 and the method of claim 12.

However Gogulski as modified by Axelrod does not disclose or fairly suggest that the coded data is redundantly encoded using Reed-Solomon encoding.

Tame however discloses that the coded data is redundantly encoded using Reed-Solomon encoding (fig 2 par. 0046).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Tame's teaching that the coded data is redundantly encoded using Reed-Solomon encoding to the shopping system and the method of Gogulski as modified by Axelrod for the advantage of using Reed-Solomon codes that the probability of an error remaining in the decoded data is usually lower than the probability of an error if Reed-Solomon is not used.

5. Claim(s) 8-10 and 20-22 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gogulski (US 4071740) as modified by Axelrod (US 5337358) in view of Dougherty (US 6076734).

Re claim 8 & 20: Gogulski as modified by Axelrod discloses the shopping system of claim 1 and the method of claim 12. However, Gogulski as modified by Axelrod does not disclose or fairly suggest that the coded data is substantially invisible to the unaided eye.

Dougherty however discloses that the coded data is substantially invisible to the unaided eye (col 5 lines 32-40, col 9 lines 33-36).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Dougherty's teaching that the coded data is substantially invisible to the unaided eye to the shopping system and the method of Gogulski as modified by Axelrod for the purpose of ensuring that the coded data is protected from unauthorized reading.

Re claim 9 & 21: Gogulski as modified by Axelrod discloses the shopping system of claim 1 and the method of claim 12.

However, Gogulski as modified by Axelrod does not disclose or fairly suggest that the coded data is printed using infrared ink.

Dougherty however discloses that the coded data is printed using infrared ink (col 2 lines 59-64, col 4 lines 18-23, col 5 lines 32-58, col 10 lines 39-45).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Dougherty's teaching that the coded data is printed using infrared ink to the shopping system and the method of Gogulski as modified by Axelrod for the purpose of ensuring that the coded data is protected from unauthorized reading.

Re claim 10 & 22: Gogulski as modified by Axelrod discloses the shopping system of claim 1 and the method of claim 12.

However, Gogulski as modified by Axelrod does not disclose or fairly suggest that the coded data is provided on the interface surface coincident with visible markings.

Dougherty however discloses that the coded data is provided on the interface surface coincident with visible markings (fig 1 parts 32 & 34, col 2 lines 43-58, col 5 lines 48-62).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate Dougherty's teaching that the coded data is provided on the interface surface coincident with visible markings to the shopping system and the method of Gogulski as modified by Axelrod for the purpose of indicating positions of the encoded data.

Response to Arguments

6. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Gogulski (US 4071740) reference modified by Axelrod (US 5337358) reference teaches a shopping system comprising a card and a shopping receptacle comprising a sensing device. Furthermore, Gogulski modified by Axelrod teaches a shopping receptacle having a shopping receptacle identity, which is transferred to a computer system together with a card identity.

In contrast to the applicant's argument, Axelrod teaches about an apparatus for recording a transaction where the transaction includes authenticating an identification card, not just about driver's license authentication system. Axelrod specifically states that "...the term "identification card" is intended to include not only typical identification cards and similar items such as drivers licenses and employee badges, but is also intended to include any item which may be suitably carried by a person or associated with an object or other entity to be identified, and which is capable of containing information pertaining to such a person, object or other entity and a coded representation of an encrypted signal comprising a representation of such information."

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae W. Kim whose telephone number is 571-272-5971. The examiner can normally be reached on Mon-Fri 7AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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